

REMARKS

Claims 1, 2 and 7-20 remain pending. Independent claims 1 and 15 have been amended to distinguish over the prior art of record. Accordingly, Applicants respectfully submit that the present application is in condition for allowance.

I. Claim Rejections - 35 USC §103(a)

In the non-final Office Action dated December 28, 2009, claims 1, 2 and 7-19 are rejected under 35 USC §103(a) as being obvious over U.S. Patent No. 5,468,305 issued to Uchida et al.

Independent claims 1 and 15 have been amended to require the sputtering target be made of an alloy of 1 to 40at% Cr, 1 to 30at% Pt, 10 to 25at% B and a remainder of Co. No new matter was added. For example, see page 3, lines 29-31, of the present application, as filed.

In the non-final Office Action dated December 28, 2009, dependent claim 20 is indicated as containing allowable subject matter because of the following reasons:

“The closest prior art of Uchida (US 5,468,305) teaches away from the ... limitation of 10 at% boron by stating that boron should be limited to 5 at% to prevent workability from deteriorating (col. 4, lines 10-23).”

At several locations in the Uchida patent, an upper limit of 5at % B is clearly required. For example, see: the Abstract, lines 7-8; column 2, line 9; column 4, lines 20-23; claim 1, lines 9-10; claim 6, lines 8-9; and claim 10, lines 8-9, of the Uchida patent.

Each of the claims of the present application requires 10 to 25at% B.

Applicants respectfully submit that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and a *prima facie* case of obviousness cannot be properly made. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Here, Uchida clearly requires an upper limit of 5at% B due to the required workability. Increasing B beyond this “upper limit” would clearly destroy the intent, purpose and function of the invention disclosed by Uchida.

Further, “teaching away” is the antithesis of the art suggesting that the person of ordinary skill in the art go in the claimed direction. Essentially, “teaching away” is a per se demonstration of lack of obviousness. In re Fine, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Here, Uchida clearly teaches away from an alloy having greater than 5at% B. Thus, one of ordinary skill in the art at the time the invention was made would follow the teachings and instructions of Uchida and would not increase B content to above 5at% B.

For these reasons, Applicants respectfully request the above referenced obviousness rejection be reconsidered and withdrawn. Applicants respectfully submit that claims 1, 2 and 7-20 are patentable over the cited reference.

II. Conclusion

In view of the above amendments and remarks, Applicants respectfully submit that the claim rejections have been overcome and that the present application is in condition for allowance. Thus, a favorable action on the merits is therefore requested.

Please charge any deficiency or credit any overpayment for entering this Amendment to our deposit account no. 08-3040.

Respectfully submitted,
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